

REMARKS

STATUS OF THE CLAIMS

Claims 1-23 and 36 are pending in the application.

Claims 1-23 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van De Pavert, U.S. Patent No. 5,914,471, in view of Boyer et al., U.S. Patent No. 6,208,973, and further in view of Yanagihara et al., U.S. Patent No. 6,370,517.

Claims 1-23 and 36 remain pending for reconsideration, which is respectfully requested. No new matter has been added.

REJECTION

Elected pending claims 1-23 and 36 are rejected under 35 USC 103(a) as being unpatentable over Van De Pavert (US Patent No. 5,914,471), in view of Boyer et al. (U.S. Patent No. 6,208,973), and further in view of Yanagihara et al. (U.S. Patent No. 6,370,517). Yanagihara is newly cited, and, thus, newly relied upon.

Page 2, item 3, of the Office Action is the Response to Arguments, in which the Examiner asserts that the previous arguments have been considered but are moot in view of the new grounds of rejection.

The foregoing rejection is traversed as follows:

First, the claimed present invention provides, “1. (ORIGINAL) An system for transaction settlement with ***an electronic cashing card having a non-authentication processing memory and an authentication processing memory***, said system comprising: ...”

Contrary to the Office Action rejection rationale, Van De Pavert fails to be related to the claimed present invention’s ***“an electronic cashing card having a non-authentication processing memory and an authentication processing memory,”*** because Van De Pavert relates to interactions between a card and a card-operated device. The Office Action in page 3 acknowledges, “Van De Pavert does not explicitly disclose that the two balances are on a card.” Van De Pavert discusses “a method of recording usage data of a card-operated device, such as a public telephone set or a vending machine. In particular, usage data, such as totalized charges, is stored in a storage unit associated with the device” (Abstract). In Van De Pavert’s

FIG. 2, clearly the card 1, including the memory 10 that has a counter 15 and a register 17, fails to disclose or suggest (contemplate) the claimed present invention's, "***an electronic cashing card having a non-authentication processing memory***" and "***an authentication processing memory.***" Therefore, Van De Pavert fails to disclose or suggest the claimed present invention's features recited in independent claims 1, 10, 17 and 36.

So the Office Action relies on Boyer to be combined with Van De Pavert, and Boyer in column 7, lines 1-10, discusses "The cobranded payment card preferably carries two balances, one for standard transactions (retail, travel, entertainment, etc.), and one for healthcare purchases (doctors, hospitals, pharmacies, optical, dental, etc.)." However, Boyer's discussion of the cobranded payment card refers to account balances associated with an account number, the account number being stored on a card and read by a computer to access data stored on the computer that is associated with the account number. In other words, Boyer's description relied upon by the Office Action does not relate to account balances stored on a card. This is readily apparent, because none of Boyer's drawings or descriptions thereof, discusses any structure or data layout format of a card. Boyer in column 6, lines 40-67, discusses the card being a VISA card and information printed on the card. Boyer's FIG. 5 illustrates a credit card statement for a cobranded healthcare/credit card account used to access the payment system of the invention. Therefore, it is readily apparent that Boyer is not related to the claimed present invention's "***an electronic cashing card having a non-authentication processing memory and an authentication processing memory***" and clearly Boyer cannot provide an motivation to be combined with Van De Pavert, or to modify Van De Pavert, to achieve the claimed present invention. In other words, even if one combined Van De Pavert and Boyer, the combined system would be directed to the Van De Pavert's card-operated device, but not the card itself, to allow the card-operated device to carry "two balances, one for standard transactions (retail, travel, entertainment, etc.), and one for healthcare purchases (doctors, hospitals, pharmacies, optical, dental, etc.)." It is readily apparent that there is no suggestion or motivation to combine Van De Pavert and Boyer to achieve the claimed present invention's features recited in independent claims 1, 10, 17 and 36, for example, "***an electronic cashing card having a non-authentication processing memory and an authentication processing memory ... an authentication balance*** stored in ... the authentication processing memory and ***a non-authentication balance*** stored in ... the non-authentication processing memory" (e.g., claim 1).

The Office Action in page 3 acknowledges “Van De Pavert does not explicitly disclose means for comparing the non-authentication balance and the authentication balance and determining that an illegal process has been performed with the card when the non-authentication balance is larger than the authentication balance.” Of course, it is clear that Boyer also does not disclose the same. So the Office Action also newly relies on Yanagihara. Yanagihara discusses an electronic money card that stores a restriction condition for the withdrawal of electronic money per user of the card (column 1, lines 34-63). Yanagihara’s FIG. 2 and column 3, lines 11-63 discuss the “payment condition” 209 stored on the electronic money card 106 on a user basis. The Office Action relies on Yanagihara, column 5, lines 11-60, which discusses, “If the sum is equal to or smaller than the balance and the usable limit 213, 217 or 221, the user is permitted to make payment in electronic money, so that the electronic money is withdrawn, and the payment transaction is terminated after a recording of transaction data is made (step 410).” However, this Yanagihara description discusses usable limits for a user, which differs from the claimed present invention’s,

1. (ORIGINAL) An system for transaction settlement with ***an electronic cashing card having a non-authentication processing memory and an authentication processing memory***, said system comprising:

means for updating an authentication balance stored in a balance area of the authentication processing memory and a non-authentication balance stored in a balance area of the non-authentication processing memory, said means updating the authentication balance to a balance amount after settlement when a transaction is settled by an authentication process having a requirement for a personal authentication to be matched, said means ***updating the non-authentication balance to an amount less than or equal to the stored authentication balance when the transaction is settled by the authentication process***; and

means for ***comparing the non-authentication balance and the authentication balance and determining that an illegal process has been performed with the card when the non-authentication balance is larger than the authentication balance***.

In other words, the claimed present invention’s, card “***non-authentication balance***” and “***authentication balance***” of electronic monetary information or payment resource, such as (without limitation) electronic money, differ from a user’s usable limit information. It is readily apparent that Yanagihara in step 409 does not update the user’s usable limit information 213,

217 and 221, but only uses the usable limit information to determine if withdrawn amount exceeds the usable limit. Further, Yanagihara's comparison process in step 409 differs from the claimed present invention's, "**comparing the non-authentication balance and the authentication balance,**" because card "**non-authentication balance**" and "**authentication balance**" of electronic money differs from Yanagihara comparing aggregate amount of money withdrawn with usable limit information. At least, usable limit information differs from electronic balance information, so that Yanagihara fails to disclose or suggest comparing two electronic money balances.

Further, Yanagihara's FIG. 6, operation 606, discusses allowing the user to update the information on the electronic money card 106. However, Yanagihara's updating is not part of transaction settlement, which differs from the claimed present invention's, "**updating the non-authentication balance to an amount less than or equal to the stored authentication balance when the transaction is settled by the authentication process.**"

MPEP 706.02(j) sets forth a guideline on the contents of a rejection under §103: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143-2143.03 for decisions pertinent to each of these criteria." Factual findings in support of a *prima facie* case of obviousness must be supported by substantial evidence. See generally, In re Zurko, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001).

Van De Pavert, Boyer and Yanagihara fail to disclose or provide any motivation to be combined with each other, or to be modified, to achieve the claimed present invention's, "**an electronic cashing card having a non-authentication processing memory and an authentication processing memory, ... updating the non-authentication balance to an amount less than or equal to the stored authentication balance when the transaction is settled by the authentication process; and ... comparing the non-authentication balance**

and the authentication balance and determining that an illegal process has been performed with the card when the non-authentication balance is larger than the authentication balance," because, as discussed herein, Van De Pavert, Boyer (in contrast to the claimed present invention's two card balances, Boyer's discussion of the cobranded payment card refers to account balances associated with an account number, where only the account number is stored on a card, which is read by a computer to access data stored on the computer that is associated with the account number) and Yanagihara fail to disclose or suggest the claimed present invention's two card balances of "**non-authentication balance**" and "**authentication balance**." In other words, a *prima facie* case of obviousness cannot be established, because at least the prior art reference (or references when combined) of Van De Pavert, Boyer and Yanagihara, fail to teach or suggest all the claim limitations.

Furthermore, Yanagihara fails to disclose or suggest the claimed present invention's, "*updating the non-authentication balance to an amount less than or equal to the stored authentication balance when the transaction is settled by the authentication process;* and ... *comparing the non-authentication balance and the authentication balance and determining that an illegal process has been performed with the card when the non-authentication balance is larger than the authentication balance,*" because Yanagihara discusses a usable limit for a user, which differs from the claimed present invention's, "*comparing the non-authentication balance and the authentication balance and determining an illegal process ...*" Yanagihara is silent on using or providing the claimed present invention's two card balances of "**an authentication balance**" and "**a non-authentication balance**."

A benefit of the claimed present invention is, for example, when the card "**authentication balance**" is lowered after settlement via an authentication process, the card "**non-authentication balance**" is also lowered to an amount less than or equal to the stored authentication balance (i.e., "*updating the non-authentication balance* to an amount less than or equal to the stored authentication balance *when the transaction is settled by the authentication process*"). In other words, the card "**non-authentication balance**" reflects disbursement from the card "**authentication balance**" to improve transaction security, because of "*determining that an illegal process has been performed with the card when the non-authentication balance is larger than the authentication balance,*" so, for example, improper deposits to the card "**non-authentication balance**" to continue non-authentication transactions

can be limited and also the amount of money available for a settlement via a non-authentication money processing by shifting from the card authentication balance can be limited (see, page 7, lines 26-29; page 8, lines 1-6; page 16, lines 11-16; and page 18, lines 11-26, of the present Application).

In view of the remarks, withdrawal of the rejection of pending claims and allowance of pending claims is respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Respectfully submitted,
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